

**Notice of Allowability**

Application No.

09/600,509

Applicant(s)

YODO, FUMITAKE

Examiner

JOHN M. WINTER

Art Unit

3621

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the paper filed by the Board of Patent Appeals and Interferences on November 29, 2007.
2. ☒ The allowed claim(s) is/are 1, 4, 5 and 7.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application                     |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>12/5/2007</u> | 7. <input type="checkbox"/> Examiner's Amendment/Comment                              |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                    | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|   | 9. <input type="checkbox"/> Other _____   |

## **DETAILED ACTION**

### ***Acknowledgements***

1. The IDS filed on December 5, 2007 has been fully considered.
2. The USPTO Board of Patent Appeals and Interferences ("Board") issued a decision on November 29, 2007 ("2007 Board Decision"). The 2007 Board Decision was based in part on Applicant's appeal brief filed January 20, 2006 ("2006 Appeal Brief"). In response to the 2006 Appeal Brief, the Examiner issued an Examiner's Answer ("2006 Examiner's Answer").
3. Prior to the 2007 Board Decision, an oral hearing was held October 25, 2007 ("First Oral Hearing"). Transcripts of the First Oral Hearing were mailed on November 28, 2007 ("First Oral Hearing Transcripts").
4. Paper No. is provided for reference purposes only.

### ***Reasons for Allowance***

5. The following is an Examiner's statement of reasons for allowance:
6. Prior to the First Oral Hearing and on page 4 of the 2006 Appeal Brief, Applicant expressly stated in the section titled "Summary of Claimed Subject Matter" that the claimed "second controller" was "(19 in Fig. 3)." A review of the original figures shows that Applicant has clearly identified a "modem" as element 19 in Fig. 3. In reliance on Applicant's position, the subsequent Examiner's Answer maintained the Examiner's position that when applying the prior art, the second controller was a modem. See Appendix A, Figure 1, "B." At the time of the Examiner's answer, the Examiner's position (as to what constituted the claimed "second controller") was consistent with the First Appeal Brief.

7. However during the First Oral Hearing, Applicant gave a new interpretation of the claimed "second controller" that had *never been before the Examiner*. In particular, Applicant argues for the first time that the second and first controllers share the *same* CPU:

JUDGE FRISCHETT (sic): First and second controllers, though, are within the same device, the general device.

MR. ZIDEL: Right.

JUDGE FISCHETTI: And you say that they share the same CPU?

MR. ZIDEL: Yeah.

JUDGE FISCHETTI: So you can draw like a little dash-line between this thing called controller and basically called one-half 1, and the other one 22nd?

MR. ZIDEL: Right.<sup>1</sup>

8. In an attempt to understand this new interpretation, the Examiner has provided Figure 1 (see Appendix) to clarify (according to the interpretation as argued by Applicants during the First Oral Hearing) what *is* and what *is not* the second controller. In particular, the Examiner has drawn the so called "little dash-line" between the first and second in controllers. See Appendix 1, Figure 1, "A." This interpretation was the basis for the Board's reversal in the 2007 Board Decision. In particular and using this new interpretation of the second controller, the Board reversed the Examiner and expressly stated:

Modem 40 of Peterson [the primary prior art reference] is not a controller adapted to set the remaining accounting point information to an initial value. . . . Modem 40 is a device that transmits information between controller 32 and accounting center 16 but is not capable of calculations necessary to set accounting information to an initial value of the terminal device.<sup>2</sup>

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<sup>1</sup> First Oral Hearing Transcripts, Page 10, Lines 15-23.

<sup>2</sup> 2007 Board Decision, Pages 5, Lines 20 to Page 6, line 1.

*New Matter*

9. The Examiner again notes that this new interpretation of the claimed "second controller" has never been before the Examiner. Thus, these "Reasons for Allowance" are the first time the Examiner has had an opportunity to respond to this new interpretation of "second controller."

10. The Examiner also notes that "members of the board have authority to *examine or reexamine* appealed claims. [Emphasis in original]." *In re Loehr*, 500 F.2d 1390, 1392-93, 183 USPQ 56, 58 (CCPA 1974). When exercising their authority to examine appealed claims, the Board (like the USPTO Patent Examining Corp), can not waive statutory requirements. See *In re Mother Tucker's Food Experience, Inc.*, 925 F.2d 1402, 1404-05, 17 USPQ2d 1795, 1797-98 (Fed. Cir. 1991) (noting that PTO cannot waive statutory requirements).

11. Because the Board has the authority to examine appealed claims, because the Board has no authority to waive or disregard statutes, and because the new interpretation of the claimed "second controller" is now for the first time, before the Examiner, it is the Examiner's position that if the Board believed that this new interpretation of the claimed "second controller" was in violation of a statute or rule, the Board would have either made those rejection(s) and/or objection(s) or simply not accepted Applicant's arguments. In other words, if the Board believed that the new interpretation of the claimed "second controller" was in violation of the prohibition against new matter under 35 U.S.C. §112 1st paragraph, the Board would have either made a new §112 1st paragraph rejection pursuant to 37 C.F.R. §41.50(b), or alternatively, articulated in the 2007 Board Decision that the claimed interpretation as argued by Applicant in the First Oral Hearing was not supported in the original specification. The Board has no choice but to assume

this duty because (as noted repeatedly), the proffered claim construction has--at the time of the 2007 Board Decision--never yet been before the Examiner. Moreover, the consequences of the Board not assuming this duty would lead to the continual "second guessing" of the Board by patent examiners on all kinds of matters. This second guessing would consume significant resources of the applicant, the examiner, the Board, and others at the USPTO and further extend the pendency of the patent application.

12. Along the same lines of reasoning and pursuant to the Board's authority noted above, if the Board believed that the newly proffered interpretation of the claimed "second controller" did not have proper antecedent basis under 37 C.F.R. §1.75(d)(1) as interpreted in MPEP § 608.01(o), the Board would have either objected to the claim language, or alternatively, articulated in the 2007 Board Decision that the interpretation offered by Applicant's in the First Oral Hearing not have antecedent basis in the original specification.

13. Finally, the Examiner notes that at the very least, it would be inconsistent with the Board's role as the primary reviewing body of the USPTO Patent Examining Corp to reverse an examiner's interpretation of the claims and adopt an interpretation of the claims that was in violation of a statute or rule.

14. In light of the above, the Examiner makes no findings whatsoever as to whether or not the new claim interpretation of the claimed "second controller" has support under 35 U.S.C. §112 1st paragraph and proper antecedent basis under 37 C.F.R. §1.75(d)(1). Instead, it is hereby presumed that the Board contemplated these issues prior to its decisions in the 2007 Board Decision.

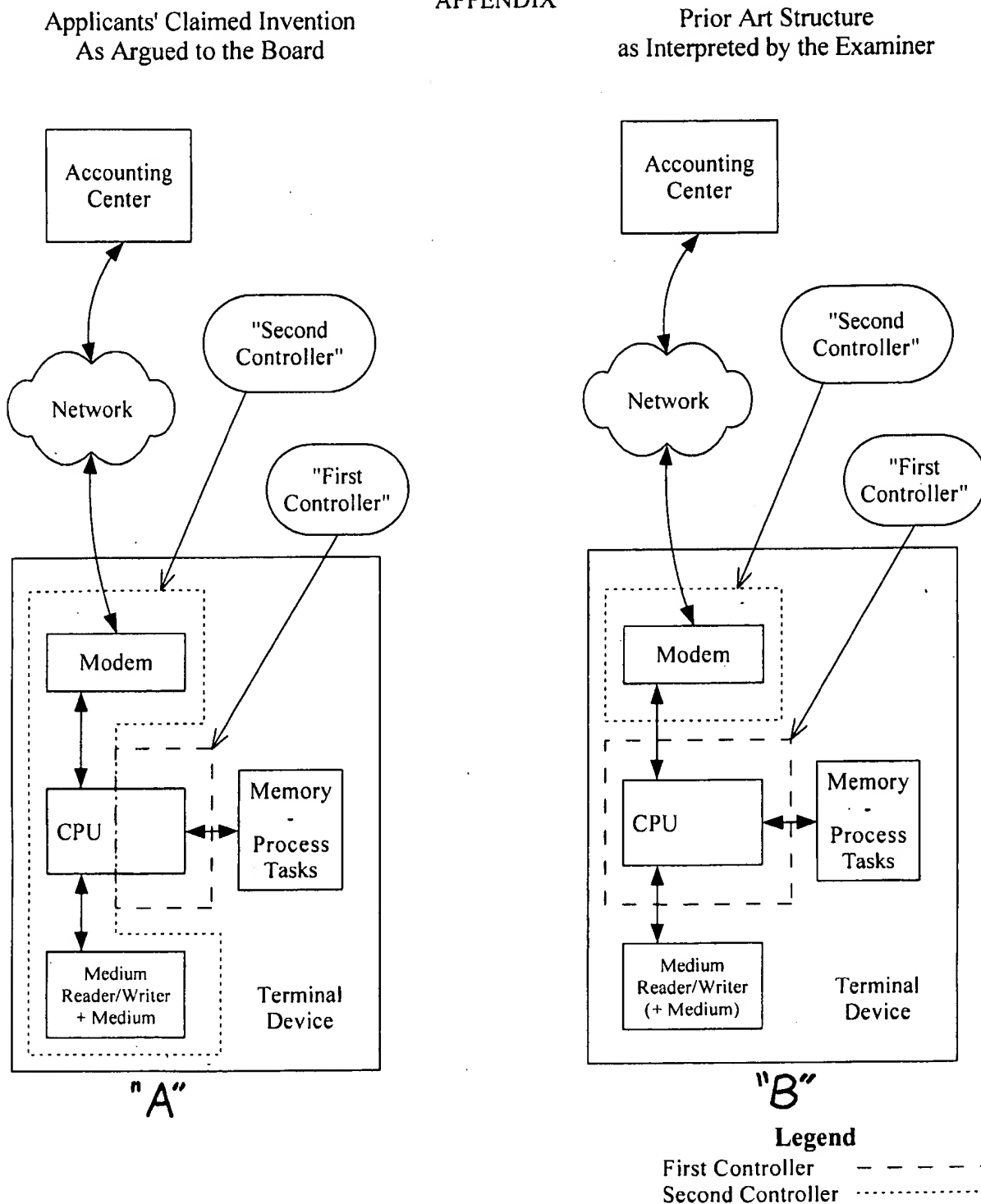
15. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

John Winter  
Art Unit 3621



ANDREW J. FISCHER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

APPENDIX



**Figure 1:** Comparison of: Applicants' Claimed Invention as Argued to the Board vs. Prior Art Structure as Interpreted by the Examiner